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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/485,441 05/10/00 BALAZS

L 1060-136P

002292 HM12/1106  
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EXAMINER

COLEMAN, B

ART UNIT

PAPER NUMBER

1624

DATE MAILED:

11/06/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trad marks**

# Office Action Summary

Application No.  
**09/485,441**

Applicant(s)  
**BALAZS et al.**

Examiner  
**Brenda Coleman**

Art Unit  
**1624**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Aug 14, 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-11, and 13-17 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

Claims 1-17 are pending in the application.

This action is in response to applicants' amendment dated August 14, 2001. Claims 17 and 18 are newly added.

#### *Response to Arguments*

Applicant's arguments filed August 14, 1999 have been fully considered with the following effect:

1. The applicant's amendments are sufficient to overcome the 35 USC § 112, first paragraph rejection of the last office action, which is hereby **withdrawn**.
2. The applicant's amendments are sufficient to overcome the 35 USC § 112, second paragraph rejections labeled a), b), d), e), f), g), h), i), j) and k) of the last office action, which are hereby **withdrawn**.
  - b) The applicant's arguments with respect to the rejection labeled c) have been fully considered but are not found persuasive. The applicants' stated that they have amended the claims to delete the phrase "which latter is optionally substituted". It is noted that the phrase was deleted from claims 1, 16 and 17. However, the phrase still remains in claim 9.

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Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For reasons of record and stated above.

3. With regards to the 35 U.S.C. § 102, anticipation rejection of claims 1, 5-9 and 13-17 by Hamori et al., WO 96/04283 of the last office action, the applicant's amendments and arguments have been fully considered but are not found persuasive. The applicants' stated that the claims were amended to "remove any overlapping subject matter". The proviso of the instant invention is such that (1) if A forms together with B a valence bond,  $R^2$  stands for an amino group and p has a value of 0, then  $R^6$  is different from a  $C_{1-4}$  alkoxy group and (2) if A forms together with B a valence bond,  $R^2$  stands for an amino group and p has a value of 0 or 1, and  $R^6$  represents a group of the formula  $-NR^7R^8$ , then one of  $R^7$  and  $R^8$  is different from a hydrogen atom or a  $C_{1-4}$  alkyl group. Hamori teaches compounds **for example** where  $R^2$  is nitro which is not excluded by the proviso above.

Claims 1, 5-9 and 13-17 are rejected under 35 U.S.C. § 102(b) as being anticipated by Hamori et al., WO 96/04283. For reasons of record and stated above.

4. With regards to the 35 U.S.C. § 102, anticipation rejection of claims 1-3, 5-7, 9-11 and 13-17 by Tarnawa et al., Bioorganic & Medicinal Chemistry Letters of the last office action, the applicant's amendments and arguments have been fully considered but are not found persuasive. The applicants' stated that the claims were amended to "remove any overlapping subject matter".

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The proviso of the instant invention is such that (3) if each of A and B stands for a hydrogen atom, n and m have a value of 0, then one of R<sup>3</sup> and R<sup>4</sup> represents a hydrogen atom, and the other of R<sup>3</sup> and R<sup>4</sup> is different from a hydrogen atom or a C<sub>1-4</sub> alkyl group and (4) if each of A and B stands for a hydrogen atom, n has a value of 0, m has a value of 1 or 2, and one of R<sup>3</sup> and R<sup>4</sup> represents a hydrogen atom or a C<sub>1-4</sub> alkyl group, then the other of R<sup>3</sup> and R<sup>4</sup> is different from a hydrogen atom or a C<sub>1-4</sub> alkyl group. Tarnawa teaches compounds **for example** where one of R<sup>3</sup> and R<sup>4</sup> represents a phenyl group which is not excluded by the proviso above.

Claims 1-3, 5-7, 9-11 and 13-17 are rejected under 35 U.S.C. § 102(b) as being anticipated by Tarnawa et al., Bioorganic & Medicinal Chemistry Letters. For reasons of record and stated above.

5. With regards to the 35 U.S.C. § 102, anticipation rejection of claims 1-3, 5-7, 9, 10 and 13-17 by Andrási et al., U.S. Patent Numbers 5,639,751; 5,459,137; 5,521,174; 5,519,019; 5,604,223; and 5,536,832 of the last office action, the applicant's amendments and arguments have been fully considered but are not found persuasive. The applicants' stated that the claims were amended to "remove any overlapping subject matter". The proviso of the instant invention is such that (3) if each of A and B stands for a hydrogen atom, n and m have a value of 0, then one of R<sup>3</sup> and R<sup>4</sup> represents a hydrogen atom, and the other of R<sup>3</sup> and R<sup>4</sup> is different from a hydrogen atom or a C<sub>1-4</sub> alkyl group and (4) if each of A and B stands for a hydrogen atom, n has a value of 0, m has a value of 1 or 2, and one of R<sup>3</sup> and R<sup>4</sup> represents a hydrogen atom or a C<sub>1-4</sub>

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alkyl group, then the other of  $R^3$  and  $R^4$  is different from a hydrogen atom or a  $C_{1-4}$  alkyl group. Andrási teaches compounds **for example** where one of  $R^3$  and  $R^4$  represents a phenyl group which is not excluded by the proviso above.

Claims 1-3, 5-7, 9, 10 and 13-17 are rejected under 35 U.S.C. § 102(b) as being anticipated by Andrási et al., U.S. Patent Numbers 5,639,751; 5,459,137; 5,521,174; 5,519,019; 5,604,223; and 5,536,832. For reasons of record and stated above.

6. With regards to the 35 U.S.C. § 103, obviousness rejection of claims 1, 5-9 and 13-17 by Hamori et al., WO 96/04283 of the last office action, the applicant's amendments and arguments have been fully considered but are not found persuasive for reasons stated above with respect to the 35 U.S.C. § 102 rejection of claims 1, 5-9 and 13-17.

Claims 1, 5-9 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamori et al., WO 96/04283. For reasons of record and stated above.

7. With regards to the 35 U.S.C. § 103, obviousness rejection of claims 1-3, 5-7, 9, 10 and 13-17 by Andrási et al., U.S. Patent Numbers 5,639,751; 5,459,137; 5,521,174; 5,519,019; 5,604,223; and 5,536,832 of the last office action, the applicant's amendments and arguments have been fully considered but are not found persuasive for reasons stated above with respect to the 35 U.S.C. § 102 rejection of claims 1-3, 5-7, 9, 10 and 13-17.

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Claims 1-3, 5-7, 9, 10 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over András et al., U.S. Patent Numbers 5,639,751; 5,459,137; 5,521,174; 5,519,019; 5,604,223; and 5,536,832. For reasons of record and stated above.

In view of the amendment dated August 14, 2001, the following new grounds of rejection apply:

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 5-7 and 13-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

- a) Claim 5 is vague and indefinite in that it is not known what is meant by the limitation "A forms together with B a valence bond" in the first and second proviso.
- b) Claims 6 and 7 are vague and indefinite in that it is not known what is meant by the limitation "A forms together with B a valence bond" in the proviso.
- c) Claim 13 is vague and indefinite in that it is not known what is meant by the limitation "A forms together with B a valence bond" in the first and second proviso.

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- d) Claims 14 and 15 are vague and indefinite in that it is not known what is meant by the limitation "A forms together with B a valence bond" in the proviso.
- e) Claim 15 is vague and indefinite in that it is not known what is meant by the phrase "or a morpholino group, wherein the phenyl group" in the definition of R<sup>7</sup> and R<sup>8</sup> on page 31.
- f) Claim 15 recites the limitation "A represents a hydrogen atom, B represents a hydrogen atom" in the definitions of A and B. There is insufficient antecedent basis for this limitation in the claim.

#### ***Claim Objections***

9. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Allowable Subject Matter***

10. Claim 4 is allowed. None of the prior art of record nor a search in the pertinent art area teaches the compounds of formula I as claimed herein.

#### ***Conclusion***

11. Applicants' attention is directed to U.S. Patent Numbers 5,639,751; 5,521,174; 5,519,019; 5,604,223; and 5,536,832, claims subject matter that is similar and/or identical to that



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claimed herein. Two patents cannot issue on the same subject matter, unless applicants can demonstrate that the claims are patentably distinct from the claims of this US patent, the only way to overcome this patent is by way of Interference proceedings or removal of the conflicting subject matter. See MPEP 2306.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

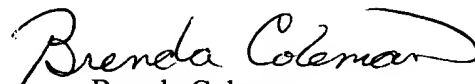
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is (703) 305-1880. The examiner can normally be reached on Mondays and Tuesdays from 9:00 AM to 3:00 PM and from 5:30 PM to 7:30 PM and on Wednesday thru Friday from 9:00 AM to 6:00 PM.

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The fax phone number for this Group is (703) 308-4734 for "unofficial" purposes and the actual number for **OFFICIAL** business is **308-4556**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

A handwritten signature in black ink that reads "Brenda Coleman". The signature is fluid and cursive, with a long horizontal stroke at the end.

Brenda Coleman  
Primary Examiner AU 1624  
November 2, 2001